

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): William H. Barber, et al.

Group Art No.: 3627

Serial No.: 09/578,631

Examiner: Asfand M. Sheikh

Filed: 25 May 2000

Confirmation No. 5757

For: DISK DISPENSING AND
RETRIEVAL SYSTEM AND
ASSOCIATED METHODS

22 May 2008

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Dear Sir:

A replacement “Status of the Claims” section is submitted herewith, in compliance with 37 C.F.R. §41.37 and fully responsive to the Notification of Non-Compliant Appeal Brief dated 25 April 2007 (“the Notification”).

The Notification stated that the Appeal Brief filed 18 April 2008 was defective because:

“The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or it does not identify the appealed claims.” See the Notification at page 2, item number 2.

The Patent Appeal Center Specialist further asserted that the brief did not include “status of all claims (cancelled claims).” See Notification at page 2, item 10.

Appellants respectfully submit that the Notification was issued in error. 37 C.F.R. 41.37 (c)(1)(iii) requires a statement of all claims, “i.e., for each claim *in the case*, appellant must state whether it is cancelled, allowed or confirmed, rejected, withdrawn,

objected to, etc. ***Each claim on appeal must be identified.***” 37 C.F.R. 41.37(c)(1)(iii), emphasis added.

Since it is questionable whether previously cancelled claims can be considered "in the case," and since previously cancelled claims are not on appeal, Appellants believe that there is no requirement to identify status of these claims.

However, in order to advance this case to the Board of Appeals, a replacement “Status of the Claims” section is appended hereto. The replacement section states that claims 22 and 63 were previously cancelled. The replacement section serves to replace section III of the 18 April 2008 Appeal Brief. Pursuant the Notification, “[t]he entire brief is not required, only the section that was found defective.” See the Notification at item 10.

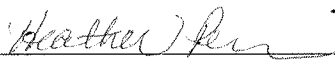
CONCLUSION

This Response and the replacement “Status of the Claims” section are submitted within one month of the mailing date of the Notification of Non-Compliant Appeal Brief. Accordingly, these items are timely filed. No fees are believed due; however, if any fee is deemed necessary in connection with this paper or the impending appeal, please charge Deposit Account No. 12-0600.

Should any questions remain, please telephone the undersigned agent.

Respectfully submitted,
LATHROP & GAGE L.C.

By


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REPLACEMENT STATUS OF CLAIMS SECTION
to the Appeal Brief filed 18 April 2008

Prepared responsive to the 4/25/2008 Notice of Non-Compliant Appeal Brief

U.S. Serial No. 09/578,631

Atty. Docket No. 387953

(III) Status of claims.

Claims 1-21, 23-62 and 64-86 are pending in this application, with claims 1 and 43 being independent. Claims 22 and 63 were previously cancelled. Claims 15-17 and 56-58 are allowed. Claims 1-14, 18-21, 23-55, 59-62 and 64-86 are being appealed herein.

Claims 4, 6, 7, 13, 27, 31, 32, 34, 36-41, 44, 46-48, 51-54, 58, 64, 68, 72, 74, 75 and 77-83 are original (without claim amendment during prosecution). Claims 1-12, 18-21, 26-29, 34-39, 41-53, 67-69, 70, 75-80, 82, 83, 84 and 86 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,159,560 ("Newell") in view of U.S. Patent No. 6,182,857 ("Hamm"), U.S. Patent No. 5,934,439 ("Kano") and U.S. Patent No. 5,739,512 ("Tognazzini"). Claims 13 and 54 stand rejected as being unpatentable, under 35 U.S.C. §103(a), over Newell in view of Hamm, Kano and Tognazzini as applied to claim 1, and further in view of U.S. Patent No. 5,938,510 ("Takahashi"). Claims 14 and 55 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Newell in view of Hamm, Kano, Tognazzini and Takahashi (as applied to claims 13 and 54), and further in view of U.S. Patent No. 4,872,154 ("Sakagami"). Claims 30-32, 71 and 72 stand rejected as being unpatentable, under 35 U.S.C. §103(a), over Newell in view of Hamm, Kano and Tognazzini (as applied to claims 27 and 70) and further in view of U.S. Patent No. 5,822,291 ("Brindze"). Alternatively, claims 30-32, 71 and 72 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Newell in view of Hamm, Kano and Tognazzini (as applied to claims 27 and 70) and further in view of JP 7-182659. Claims 33, 73 and 74 stand rejected as being unpatentable, under 35 U.S.C. §103(a), over Newell in view of Hamm, Kano and Tognazzini (as applied to claims 1 and 43) and further in view of U.S. Patent No. 5,900,608 ("Iida").

There is some confusion over the rejection of claims 23-25 and 64-66. The pending office action first states, in an introductory paragraph, that these claims stand rejected under 35 U.S.C. §103(a), as being unpatentable over Kano in view of U.S. Patent No. 6,554,184 ("Amos") and further in view of U.S. Patent No. 5,459,306 ("Stein"). However, the detailed rejection of these claims is based

upon the combination of Newell, Hamm, Kanoh, Tognazzini and Stein. Appellants believe that the Examiner intends to rely upon the latter combination of patents. Hence, the latter combination is argued herein.

Claims 39, 40, 80 and 81 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Newell in view of Hamm, Kanoh and Tognazzini and further in view of U.S. Patent No. 4,995,498 ("Menke"). Claims 42, 82 and 83 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Newell in view of Hamm, Kanoh, Tognazzini and Menke, and further in view of U.S. Patent No. 4,903,815 ("Hirschfeld"). Claim 85 stands rejected as being unpatentable, under 35 U.S.C. §103(a), over Newell in view of Hamm, Kanoh and Tognazzini, and further in view of U.S. Patent No. 5,971,273 ("Vallaire"). Claims 15-17 and 56-58 are objected to as being dependent upon a rejected base claim; however, the Examiner has indicated that these claims would be allowable if rewritten in independent form, including all limitations of the base claim and any intervening claims.